UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/803,339 | 03/09/2001 | Richard A. Wiltshire | 122923-1000 | 7334 |

7590 05/09/2003

Todd E. Landis
Gardere Wynne Sewell, LLP
3000 Thanksgiving Tower
1601 Elm Street Suite 3000
Dallas, TX 75201-4767

| EXAMINER | |
|---|---|
| WHITE, CARMEN D | |
| ART UNIT | PAPER NUMBER |
| 3714 | |

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/803,339 | Applicant(s) WILTSHIRE ET AL. |
|---|---|---|
| | Examiner Carmen D. White | Art Unit 3714 |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-8, 10-16, 20, 22-24, 27, 29-37 and 39-44 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Luciano*** et al (6,168,521) or ***Yacenda*** (6,322,446).

Regarding claims 1-2, 4, 6-8, 10-16, 20, 23-24, 27, 30-31, 33, 35-37 and 39-43, Luciano or Yacenda teaches a lottery pooling management system that comprises a participant interface, the participant interface being in communication with a participant computer, the participant interface being configured to allow pool participants to participate in one or more lottery pools, each lottery pool having one or more sets of lottery numbers; a lottery interface, the lottery interface being in communication with one or more lotteries and the participant interface, the lottery interface being configured to ascertain drawing results and jackpot amounts for the one or more lotteries and to compare the drawing results with the one or more sets of lottery numbers in the one or more lottery pools; and a notification interface, the notification interface being in

communication with the participant interface and the lottery interface, the notification interface being configured to alert pool participants about activity in the one or more lotteries, the status of the lottery pool, and the compared drawing results (Luciano-Fig. 1; Fig. 2; Fig. 3; Fig. 8; col. 2, lines 33-65; col. 3, lines 1-28; Yacenda- Fig. 1; Fig. 2A and Fig. 2B).

Regarding claims 3 and 32, Luciano teaches all the limitations of the claims as discussed above. Luciano further teaches the entry and editing of the numbers by the players (Fig. 3, #38- see "Enter" input as well in this figure).

Regarding claims 5 and 34, Luciano teaches all the limitations of the claims as discussed above. Luciano further teaches the replay of the numbers (lines 5-7 of abstract).

Regarding claims 22, 29 and 44, Yacenda teaches all the limitations of the claims as discussed above. Yacenda further teaches the network being the Internet (col. 4, lines 34-36).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9, 21, 28 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Luciano*** et al (6,168,521).

Regarding claims 21 and 28, Luciano teaches all the limitations of the claims as discussed above. Luciano further teaches the display of results so as to add excitement to the game (see last sentence of abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify this concept taught by Luciano to further include the highlighting of matches to increase the excitement and to add an aesthetic appeal that would attract players to the lottery game.

Regarding claims 9 and 38, Luciano teaches all the limitations of the claims as discussed above. While Luciano teaches the feature of replaying the ticket in a future lottery (abstract), Luciano is silent regarding the feature of notifying the player of an updated jackpot amount. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Luciano to increase the player's anticipation of winning larger jackpots in the future.

Claims 17-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Yacenda*** (6,322,446).

Regarding claim 17, Yacenda teaches all the limitations of the claims as discussed above. While Yacenda teaches the electronic notification {online} (col. 3, lines 59-60), Yacenda is silent on the particular means of electronic notification. The examiner takes official notice that it is well known in the art to use e-mail as a form of online communication. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate e-mail notification in Yacenda to make the process of winner notification quicker and more convenient for the player; whereby the player would not have to track the winning outcome(s) him/herself.

Regarding claims 18 and 25, Yacenda teaches all the limitations of the claims as discussed above. Yacenda further teaches the monitoring of the time remaining (Fig. 3, #201). However, Yacenda is silent regarding alerting the participants of time remaining before the lottery closes. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature in Yacenda to allow the participant a fair opportunity to choose lottery picks before being disqualified.

Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Yacenda*** (6,322,446) in view of ***Luciano*** et al (6,168,521).

Regarding claims 19 and 26, Yacenda teaches all the limitations of the claims as discussed above. Yacenda is silent regarding the feature of alerting the winner with a varying color scheme. However, in an analogous lottery system, Luciano teaches displaying the lottery results in such a manner as to provide the excitement (last sentence of abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to enhance the display of results of Yacenda, as taught by Luciano, and to further enhance both Yacenda and Luciano by providing a color output to increase the excitement of the game and to add an aesthetic appeal that attracts players.

***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al (6,312,332) teaches a lottery system whereby a group of participants "pool" together to forma a team.

***Examiner's Response to Applicant's Remarks***

Applicant argues that the prior art of record Luciano et al and Yacenda do not anticipate the instant claims. Applicant further argues that the examiner has not met the basic criteria for establishing a prima facie case of obviousness with the Luciano and Yacenda references under 35 U.S.C. 103 (a). Applicant's rationale for this argument is based on Applicant's allegation that neither Luciano nor Yacenda teach the instant claim feature of a "lottery pool".

Applicant states on page 7 of the remarks, in the last paragraph, that the current invention claims a "*lottery pool, where individuals generally get several lottery tickets together to create a larger pool of potentially winning numbers for the group*". Applicant goes on to indicate where this can be found in the instant specification. However, Applicant argues language that is different from the recited claim language. Applicant's claim merely uses the language "lottery pool". Applicant has not claimed a *group of individuals getting several lottery tickets together to create a larger pool*... Applicant is reminded that while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the case of the Yacenda reference, Yacenda teaches a lottery system that allows a plurality of players to play from a plurality of player terminals over a global network (col. 2, lines 27-46). The examiner has interpreted the feature of a plurality of players playing over a network, whereby the winning players are notified, as a lottery

pool. Further, Luciano teaches a similar lottery system as Yacenda that has a plurality of players playing via a network. Luciano also refers to a "lottery pool", whereby a portion of the wagers from each of the players is part of the prize pool (col. 4, lines 1-17).

Applicant has argued the language "lottery pool" more narrowly than it is currently being claimed in the instant invention. The examiner maintains that Luciano and Yacenda both clearly teach a lottery pool.

Also, the examiner has cited Walker et al (see above "Pertinent Prior Art") as a reference that teaches the pooling together of participants in a team to play a lottery, which is the feature that Applicant argues, but has not clearly claimed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for ***Non-official*** communications and 703-305-3579 for ***Official*** communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

cdw

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700